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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Ex Parte WOLFGANG MAUS

Appeal 2011-001448
Application 10/763,027
Technology Center 1700

Oral Hearing Held: November 9, 2011

Before ADRIENE L. HANLON, CHUNG K. PAK, LINDA M. GAUDETTE, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:

ALFRED K. DASSLER
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The above-entitled matter came on for hearing on Wednesday, November 9, 2011, commencing at 9:03 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Victor Lindsay, a Notary Public.

PROCEEDINGS

THE USHER: Good morning. Calendar No. 16, Appeal No. 2011-001448, Mr. Dassler.

JUDGE HANLON: Thank you.

THE USHER: Uh-huh.

JUDGE HANLON: Good morning, Mr. Dassler.

MR. DASSLER: Good morning.

JUDGE HANLON: If you have a business card, it would be much appreciated. Thank you.

JUDGE HANLON: You have 20 minutes and you can begin when you're ready.

MR. DASSLER: Twenty minutes?

JUDGE HANLON: Yes.

MR. DASSLER: Okay. My hearing's a little clogged. I have a cold and I had some problem with the flight, so I apologize if I have to ask you to repeat. Okay, I'd like to start by referring to the instant application and the disclosure therein that the instant application is concerned with eliminating the barrel-shaped deformation that results from repeated thermal expansion and contractions that occur for a honeycomb body within a casing. The Examiner's first rejection is over *Ota*, and here the Examiner merely relies

on Figures 1, 2, 3, 5 and 6, and alleges that a contraction limiter is shown by the reference symbols 5, 9A, 9B, 10, and 11, respectively.

But the Examiner has not at all supported this allegation with any written disclosure within *Ota*. And in fact, the written specification of *Ota* contradicts the Examiner's allegation that these elements are, in fact, contraction limiters. Instead, *Ota* explicitly discloses that they are cushioning members and, to that end, discloses that -- explicitly discloses that -- the cushion members serve to indirectly join the housing to the case, the housing case to the honeycomb body, so as not to constrain expansion and contraction of the honeycomb which is shown in column 4, lines 23 through 29 of *Ota*. Also in column 7, lines 1 through 5 of *Ota*.

JUDGE PAK: Counsel, how did you define your contraction limiter in your specification?

MR. DASSLER: In the specification?

JUDGE PAK: Yeah. In your specification, how did you limit your claim indication?

MR. DASSLER: Excuse me. I couldn't hear you.

JUDGE PAK: How did you define in your specification, relative to the claim terminology, that contraction limiter?

MR. DASSLER: Oh. The contraction limiter is described as several locations, but mainly that -- let's see -- page 4 is the first example. Line 5, line 6, "At least one contraction limiter causing an outwardly-directed tensile stress in at least one part of the matrix so that the average initial diameter of the matrix decreases by at most 5% during and after the thermal stress."

JUDGE PAK: I mean, this description only indicates the function of the contraction limiter, right?

MR. DASSLER: The function?

JUDGE PAK: Function. I mean, is there any description of a structure?

MR. DASSLER: There's description with respect to thermal properties of the material and the surface specific heat and also the -- let's see -- if you look at the paragraph bridging pages 4 to 5, the contraction limiter permits expansion and or contraction of the matrix and, accordingly, does not obstruct these processes as severely as the housing. Let's see. Right here, line 10 -- or line 11, "The contraction limiter to have a predeterminable thermal expansion behavior that is displaced in terms of time or in relation to temperature in comparison with the matrix." I mean, there are different areas which disclose that it's based on the thermal properties coefficient of expansion.

JUDGE PAK: You claim, as well as you stated in this packet, that the contraction limiter is configured to provide those functions or properties.

MR. DASSLER: Yes.

JUDGE PAK: And when you say configure, I presume you are talking about some sort of configuration, shape of the structure.

MR. DASSLER: It's the physical properties. If I go to a chart, it has a certain tensile strength. It's the material properties that are a physical characteristic. It has a thermal coefficient of expansion. It has the surface specific heat. If you look at line 20, "under some circumstances for the surface specific heat capacity of the contraction limiter to be placed in a

region lying between the surface specific heat capacity of the matrix and the housing. The different thermal expansion and contraction behavior of the matrix and the housing ensures that the thermal behavior of the matrix is influenced positively, in particular is slowed down, in the above-described manner, while at the same time too rigid a casing around the matrix is avoided."

So its material properties, and those are structural properties of these contraction limiters, but there's no -- I mean, it can be done in many different ways. Just the relationship of these different thermal characteristics of the material. If you go to any of these materials that are used, any material, you have different physical coefficients and different strengths. And that's what's disclosed in the specification.

JUDGE HANLON: You have some embodiments in Figures 3 and 4, 7A and 7B in Figure 4 it's a structure.

MR. DASSLER: Yeah.

JUDGE HANLON: It's not limited to that particular structure, is what you're arguing. So it could actually be a bar disposed between -- it could be a round ring disposed between the honeycomb core and the case?

MR. DASSLER: Yeah. There's no specific limitation as to the geometric shape of the contraction limiter. It's just that it has, you know, one geometry may work with one material while another geometry may work with a different material. So it's a combination of those elements that results in the contraction limiter as claimed. And to try and claim a specific combination would be unnecessarily narrow.

JUDGE PAK: Would this be well within the -- for trying to hold any contraction, for limiting contraction to select, as you said, pick and choose whatever known material?

MR. DASSLER: No. Because --

JUDGE PAK: Those properties were known, right? That's what you --

MR. DASSLER: It's anticipation rejection, first of all. And second of all, Applicants have identified in the specification that they are the ones that have identified this to be a problem, and that's disclosed in the specification as well.

JUDGE PAK: So the material of the prior uses is the material different from what you are using. That is, those materials don't have the same type of properties encompassed by your claims.

MR. DASSLER: Correct, because there's no disclosure in the reference as to the materials. You have a housing, you have a honeycomb body, and an element in between the contraction limiter, and each one of these has different thermal characteristics. And not only that, the center of the honeycomb body heats at a different rate than the outer casing. The heat's generated different. Those are all things that are taken into consideration in selecting these parts. And here, in the reference, there's no mention other than the explicit disclosure that he does not want to constrain -- *Ota* discloses not to constrain expansion and contraction of the honeycomb.

However, that is specifically what we are doing there. That's what the Appellants are seeking to do by the matrix. The honeycomb body is

connected to the casing, and the casing -- the force exerted on the honeycomb body is provided from the outer casing via the contraction limiter. But the disclosure of *Ota* is completely contrary to that, the written disclosure. The Examiner merely points at figures without any support in the specification.

JUDGE PAK: He didn't identify any material as being correspondent to the --

MR. DASSLER: He tried to. If you look at the, I think it was the Final Office Action, he had provided a material data sheet for a stainless steel and made some generalization. If you look on pages 4 and 5 of the Final Office Action -- actually I think it's also here on the -- it's pages 4 and 5 of the Examiner's Answer. He talks about the stainless steel of *Ota's* matrix has a coefficient of thermal expansion of -- and he gives a number here. And he cites a material web search data sheet. However, this data sheet pertains to decorative stainless steel for kitchen counters and I think kitchen elements. And then he bases it upon diameter of a matrix disclosed in a third reference, *Stroom*.

However, it's a linear expansion of these wound -- it's a wound honeycomb body, so the expansion is going to be based on the length of all the things that are wound. It's not just on the diameter. He hasn't shown any calculations here at all. He just puts a number on the end and says --

JUDGE PAK: Is your material made of stainless steel?

MR. DASSLER: It can be.

JUDGE PAK: Couldn't you say its structure can be almost any structure as long as the material is the same?

MR. DASSLER: Is the materials the same?

JUDGE PAK: Material has the desired thermal properties.

MR. DASSLER: Right. So it doesn't have to necessarily be --

JUDGE PAK: So if it's the same stainless steel material, there's reasonable basis for the Examiner to find that they must have the same contracting properties?

MR. DASSLER: Same material as what?

JUDGE PAK: Same material that is used as what you call contracting delimiting material.

MR. DASSLER: But which material are you saying is the same?

JUDGE PAK: Stainless steel. I just asked you whether the Examiner is relying on stainless steel material.

MR. DASSLER: There's many different grades of stainless steel, okay, and he chooses one that's suited for decorative applications. And I'm not saying that that material would necessarily be specific. It's for decorative structural applications. Type 301, its resistance to atmosphere and corrosion and its bright, attractive surface make an excellent choice for decorative structural applications. Applications include automobile molding and trim, wheel cover, conveyor belts, kitchen equipment, roof draining systems.

I mean, I'm not saying one way or another, but the Examiner has not shown any calculations. His calculations are based on an assumption that doesn't even pertain to this number. It's a coefficient of linear expansion. The diameter, it is linear, but the material that makes the diameter is not linear in the direction of the diameter. It's a spiral he wound and there's

corrugations. And therefore, the Examiner's allegation, furthermore, is based on the fact that the honeycomb body would never expand and contract that much, even without a contraction limiter. He relies on this to say that the honeycomb body itself won't expand and contract that much.

But as you see in our specification and in the documentation we provided in the Reply Brief with the test results showing that yes, you will achieve this barreling effect due to the expansion and contraction that occurs.

JUDGE HANLON: And that's without the contraction limiter?

MR. DASSLER: Correct. And what he's citing there is not material for the contraction limiter. He's citing material for the honeycomb body and not at all for the expansion and contraction limiter. So that's why there's no merit to it. In fact, he kind of abandoned his position on that based on an interview I had with him. If you look back, there's an interview summary, I believe, where he says as much. Or at some point, he did indicate that he kind of, you know, he was not really standing behind these arguments. I think it's in the Examiner's Answer.

Page 10, the Examiner agrees that his arguments are invalid with respect to the material data based on the thermal expansion. So to continue on, it's stated that the written disclosure of *Ota*, which is what we really have to go on, is explicit in that the thermal expansion and contraction of the honeycomb is not constrained by the case. However, that's exactly how the contraction limiter of the instant application has claimed, is configured to operate.

JUDGE PAK: The cushion member number 9 Examiner relied on is made of stainless steel. Am I correct?

MR. DASSLER: I don't see that.

JUDGE HANLON: *Ota* discloses in column 3, lines 23 to 24, "the case, the cushion member and the honeycomb are generally made of a ferritic stainless steel."

MR. DASSLER: Okay. Well it says generally, and if you look at the figures, you also see that he has this spring-shaped configuration to a lot of his embodiments which would allow this thing to flex, as he discloses. If you look at Figure 4, Figure 6, Figure 3, his elements, his cushion members, would flex and not exert those stresses required as in the instant application is claimed.

JUDGE HANLON: Now *Maus*, the Examiner also relied on that reference.

MR. DASSLER: Yes.

JUDGE HANLON: That has a similar configuration in Figure 3.

MR. DASSLER: Yes. It does.

JUDGE HANLON: And the Examiner also made an inherency rejection based on this reference.

MR. DASSLER: Correct. Yes, and here again, if I can continue on with *Ota*, the Examiner has not met the requirements of inherency for *Ota* --

JUDGE HANLON: Okay. I understand that position, but let's just turn quickly to *Maus*.

MR. DASSLER: Okay. Well likewise, in *Maus*, the Examiner here alleges that this element, the connecting tube 11, is a contraction limiter.

There's no written disclosure that supports this at all in the reference. Okay? There's nothing in the *Maus* reference that supports this position. In fact, Mr. Maus is also the Inventor of the instant application. Beyond that, *Maus* is concerned with insulating and providing insulating for the honeycomb body from the casing or outer tube. And in order to improve efficiency at startup of the catalytic reaction that occurs in his convertor.

Here, again, there's nothing in the written disclosure that indicates that the connecting tube has the physical characteristics to meet the requirements of the contraction limiter as recited in Claim 1 of the instant application. So the Examiner has not met the requirements for inherency, and certainly this element could be placed in there under compression where a compressed one is placed in there so that there's a -- it's like a spring that's pre-stressed, and that possibility alone would speak against any inherency.

JUDGE HANLON: Well this is the same Inventor, so rather than making suppositions -- can you tell us how it is?

MR. DASSLER: How it is?

JUDGE HANLON: Yeah.

MR. DASSLER: In the *Maus* reference?

JUDGE HANLON: Uh-huh.

MR. DASSLER: I mean, no, I don't -- I mean, I can only go by what's disclosed in the *Maus* reference. And, I mean, that's what's cited against us. I have not contacted the Inventor with respect to how these things are in there. And I'm not sure, short of a declaration, how that would even be, you know, anything I could put forth. And I contacted the Examiner about the possibility of filing a declaration and he indicated that

he wasn't interested in seeing anything of that nature. It wouldn't change his position.

JUDGE PAK: I presume the Applicant would have submitted if in fact this structure was material to the examination of this case.

MR. DASSLER: Excuse me. What's that?

JUDGE PAK: I presume Applicant would have submitted the declaration or information regarding the structure of this material disclosed in *Maus*, had he been aware that this information was material to the examination, right?

MR. DASSLER: Well I can't speak to that, but I mean, we have to look at the case as it's in front of us, and the Examiner's relied on inherency and it's not there. And to take the case out of appeal and file further declarations or to be required to file an RCE, it didn't seem financially reasonable to do so after the discussion with the Examiner. I mean, I think our position is the case on the references alone is what's disclosed in the reference is sufficient to overcome the reference. Therefore, no declaration was filed. And also with an anticipation rejection, it's really difficult to say what would be done with a declaration.

JUDGE PAK: What is the 11 made out of?

MR. DASSLER: 11?

JUDGE PAK: Yeah. That which the Examiner is relying on as the claimed constraint delimiter.

MR. DASSLER: I mean, I'm not sure what it is. I know at one point it says that it can act somewhat as the casing, so I would imagine it's similar in respect to what the casing is, too. I mean, I think it just mainly says

metallic. But certainly there's no disclosure that there's any difference between the materials that would result in the contraction limiting as required in the claims of the instant application. And furthermore, there's nothing in the reference that says anything about limiting contraction. It's all about thermal insulation of the honeycomb body from the outer casing in order to improve the catalytic reaction of the honeycomb body.

JUDGE HANLON: Do you have any other questions?

MR. DASSLER: Thank you.

JUDGE HANLON: Okay. Thank you.

(Whereupon, the proceedings, at 9:29 a.m., were concluded.)